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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,194	09/08/2003	Hisayasu Nakao	1046.1299	8380
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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER HAMZA, FARUK	
			ART UNIT 2455	PAPER NUMBER
			MAIL DATE 07/02/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/656,194

Applicant(s)

NAKAO, HISAYASU

Examiner

FARUK HAMZA

Art Unit

2455

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-11, 14, 16-19, 21-27, 29-37, 40, 42-53, 55-63, 66, 68-78 and 101-104 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-11, 14, 16-19, 21-22, 27, 29-37, 40, 42-48, 53, 55-63, 66 and 68-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Amendment

1. This action is responsive to the amendment filed on April 21, 2010. Claims 1, 14, 27, 40, 53 and 66 have been amended. Claims 2, 12-13, 15, 20, 28, 38-39, 41, 54, 64-65, 67 and 79-100 were previously canceled. Claims 23-26, 49-52, 75-78 and 101-104 were previously withdrawn. The applicant is respectfully requested to cancel the withdrawn claims. Claims 1, 3-11, 14, 16-19, 21-27, 29-37, 40, 42-53, 55-63, 66, 68-78 and 101-104 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 3-11, 14, 16-19, 21-22, 27, 29-37, 40, 42-48, 53, 55-63, 66 and 68-74 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The instant specification failed to provide enough description of the newly added limitation "showing a responding procedure of how to respond to a test mail according to a destination, to a user who is within a predetermined range" so that an ordinary skill in the art would be able to fully comprehend the claimed invention. The applicant failed to provide

proper reference or citation of the instant specification to support the newly added claimed limitation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-11, 14, 16-19, 21-22, 27, 29-37, 40, 42-48, 53, 55-63, 66 and 68-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubik et al. (U.S. Patent Number 6,775,691) hereinafter referred as Kubik and further in view of Tsukui et al. (U.S. Patent Number 6,557,045) hereinafter referred as Tsukui.

As to claim 1, Kubik teaches an E-mail management system for managing a forward destination of an E-mail, the E-mail management system including a processor, the processor programmed to execute:

accepting a setting request of a forward destination address corresponding to a receipt address of an E-mail addressed to the receipt address and the E-mail being to be forwarded to the forward destination address (abstract, Column 5, lines 21-46);

showing a responding procedure of how to respond to a test mail according to a destination, to a user (Column 7, lines 52-55);

executing a confirmation of a validity of the forward destination address to which the E-mail addressed to the receipt address is forwarded, by sending the test mail to the forward destination address and receiving the response to the test mail (abstract, Column 1, lines 55-64, Column 7, lines 55-Column 8, lines 30); and

wherein said confirmation includes confirming whether or not the response conforms with the designation (Column 7, lines 47-55).

Kubik does not explicitly teach the claim limitation of an address within a predetermined range.

However, Tsukui teaches the claim limitation of an address within a predetermined range (Column 6, lines 55-60).

It would have been obvious to the ordinary skill in the art at the time of the invention to modify the system of Kubik by incorporating Tsukui's teaching of managing e-mail addresses into an upper hierarchical domain name and lower hierarchical domain name because it would reduce the number of characters to be input by an operator and therefore make the system more efficient.

As to claim 3, Kubik teaches an E-mail management system according to claim 1, the processor further programmed to execute: commanding a sending device to send a test mail to the forward destination address; and communicating with a receiving device to receive a response to the test mail, wherein said confirmation includes confirming the validity of the forward destination address by

the response received by said receiving device (Column 7, lines 55-Column 8, lines 30).

As to claim 4, Kubik teaches an E-mail management system according to claim 1, further programmed to execute: registering the forward destination address corresponding to the receipt address if the confirmation proved successful; and forwarding a received E-mail addressed to the receipt address to the forward destination address, when the forward destination address corresponding to the receipt address is registered (Column 7, lines 55-Column 8, lines 30).

As to claim 5, Kubik teaches an E-mail management system according to claim 1, communicating with a mail server which registers the forward destination address corresponding to the receipt address of the E-mail, and forwards the received E-mail addressed to this receipt address to the forward destination address, wherein said confirming unit commands if the confirmation proved successful, said mail server to register the forward destination address corresponding to the receipt address via said communication unit (abstract, Column 1, lines 55-64).

As to claim 6, Kubik teaches an E-mail management system according to claim 2, wherein said confirming unit confirms whether or not the response is transmitted from the receipt address (Column 7, lines 55-Column 8, lines 30).

As to claim 7, Kubik teaches an E-mail management system according to claim 1, wherein said confirmation confirming includes sending test mails

respectively to the receipt address and the forward destination address, and confirming responses to these two test mails (Column 7, lines 55-Column 8, lines 30).

As to claim 8, Kubik teaches an E-mail management system according to claim 4, the processor further programmed to execute: registering a forward destination address unconditionally in response to said setting request for setting the forward destination address that is within a predetermined range, and registering a forward destination address with respect to which the confirmation by said confirming unit proved successful in response to said setting request for setting the forward destination address that is beyond the predetermined range (abstract, Column 7, lines 55-Column 8, lines 30).

As to claim 9, Kubik teaches an E-mail management system according to claim 1, further comprising a notifying unit notifying that a permission of forwarding to the forward destination address with respect to which the confirmation proved unsuccessful, can not be given (abstract, Column 7, lines 55-Column 8, lines 30).

As to claim 10, Kubik teaches an E-mail management system according to claim 4, wherein said confirming unit confirms a validity of the already-registered forward destination address after a predetermined period of time has elapsed since the registration thereof, and said forward control unit suspends forwarding to the forward destination address till the confirmation proves successful after the

elapse of the predetermined period of time (abstract, Column 7, lines 55-Column 8, lines 30).

As to claim 11, Kubik teaches an E-mail management system according to claim 5, wherein said communication unit receives a request for confirming the already-registered forward destination address from said mail server, and said confirming unit confirms the validity of this forward destination address (abstract, Column 7, lines 55-Column 8, lines 30).

Claims 14, 16-19, 21-22, 27, 29-37, 40, 42-48, 53, 55-63, 66 and 68-74 do not teach or define any new limitations other than above claims 1, 3-11. Therefore, claims 14, 16-19, 21-22, 27, 29-37, 40, 42-48, 53, 55-63, 66 and 68-74 are rejected for similar reasons.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context.

Response to Arguments

4. Applicant's arguments have been fully considered but they are not persuasive.

In the remarks the applicant argues in substance that; A) Kubik does not teach the claim limitation of "showing a responding procedure of how to respond to a test mail according to a destination, to a user".

In response to A) The examiner didn't find support for this claim limitation in the instant specification. Therefore, the claim is rejected under 112 1st paragraph. The examiner is not considering it at this time.

B) Kubik does not teach "accepting a setting request of a forward destination address corresponding to a receipt address of an E-mail addressed to the receipt address and the E-mail being to be forwarded to the forward destination address".

In response to B) The applicant is reminded that claim limitation must be given their reasonable broadest interpretation. Kubik teaches validating or testing a destination or recipient address prior to sending a message. In order to test the address, existing header is extended to include a test header. The test header allows a sender to test an e-mail address without sending the message. Therefore, Kubik's teaching updating header by including test header to test address without sending message meets the claim limitation.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faruk Hamza whose telephone number is 571-272-7969. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached at 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll –free).

Faruk Hamza

Patent Examiner

Group Art Unite 2455

/Faruk Hamza/

Primary Examiner, Art Unit 2455